

## **Remarks**

### **Status of the Application**

Claims 1-15, 17-24, 27-28, 35, and 37-42 are pending with the entry of this amendment. Claims 14-15 and 17-20 are indicated as being allowed. Claims 1-13, 21-24, 27-28, 35 and 37-42 stand rejected under 35 USC § 103(a).

Claims 1, 21, 35 and 39 are amended herein.

### **The Amendments**

The amendments to the claims do not add new matter to the application as originally filed. The newly added claim limitations reciting that the microtiter plates are positioned at a desired position with an error tolerance of 0.066 millimeter or less find support in the specification at, for example, page 11 (table shows that all tolerances are 0.066 millimeter or less).

### **The 35 USC § 103(a) Rejections**

Claims 1-4, 7-8 and 12-13 stand rejected under 35 USC § 103(a) as being unpatentable over Bevirt (US Patent No. 6,063,579) in view of Kercso (US Patent No. 6,132,685). To overcome this rejection, Applicants have amended claim 1 (from which the remaining rejected claims depend) to recite that the positioning device positions a microtiter plate with a tolerance of 0.066 mm or less along the particular axis that the plate is being positioned. The cited references contain no teaching or suggestion that one could obtain such precise tolerances by using the inner wall to position a microtiter plate. The positioner on the Bevirt apparatus does not position a microtiter plate within a tolerance that is sufficiently close for analysis of samples in microtiter plate wells, thereby necessitating that the height of the light beam be adjusted to compensate for positioning errors that would otherwise result in the light beam not being aligned with the well (see, e.g., column 17, lines 54-62):

“Cross-plate drift of fluorescent readings may increase as the instrument scans across the microtiter plate as variations are

compounded. Typically, drift will be worst at well H12, which is farthest from well A1. Such drift can be reduced by making the stage more accurate, by making the sample containers of a more consistent size, *or by increasing  $H_2$ , which will reduce the diameter of the beam and put it back into the well. The lattermost approach is shown [in Figure 13] for well G11.*" (emphasis added)

Although Bevirt suggest that making the stage more accurate could reduce the cross-drift errors, the reference does not provide any suggestion as to how one could accomplish that goal. The reference therefore provides an alternative: adjusting the height ( $H_2$ ) of the light beam above the microtiter plate.

The Kersco reference likewise does not provide any teaching or suggestion that one could obtain tolerances of 0.066 mm or less by having the positioners contact an inner wall of a microtiter plate. The only "advantage" that the Kersco patent discusses of having the tab fittingly received between the wells and the front edge of the plate is that such an arrangement "takes advantage of the generally unused recess between the wells and the edges of the plate." (Column 12, lines 64-65). There is no suggestion that using the inner wall to position the plate provides more precise positioning than positioners that contact an outer wall of a microtiter plate. Therefore, Applicants respectfully submit that claim 1, as amended, is patentable over Bevirt and Kersco. Since each of the remaining rejected claims also depends from claim 1, those claims are also not obvious over the cited references. Applicants request that this ground of rejection be withdrawn.

Claims 1-13, 21-24, 27-28 and 37-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Burton (WO 99/04228) or Modlin (US Patent No. 6,071,748) in view of Cathcart (US 5,443,791), Markin (US 5,417,922), Bevirt and Kercso. As the Burton and Modlin references have equivalent disclosures, and to be consistent with the Office Action, Applicants' remarks below refer to the Modlin patent. Applicants respectfully submit that the

amendments to claims 1, 21, 35 and 39 (from which all of the rejected claims ultimately depend) obviate this ground of rejection.

Bevirt, as discussed above, does not describe a positioning device in which an alignment member is in contact with an inner wall at an edge of a well area of a microtiter plate and positions the microtiter plate with a tolerance of 0.066 mm or less, as is required by independent claims 1, 21, 35 and 39 (as amended herein). Nor does either of Burton or Modlin describe such a device. Cathcart and Markin likewise do not describe any devices that meet these claim limitations. The Kercso patent also fails to provide any such teaching as described above. Since not all claim elements are described in the cited references, independent claims 1, 21, 35 and 39, as well as dependent claims 2-13, 22-24, 27-28, 37-38 and 40-42 (all of which depend from claims 1, 21, 35 or 39), are not *prima facie* obvious over the cited references.

#### Conclusion

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for examination. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1547.

Respectfully submitted,  
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